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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,972	03/11/2004	Masaya Yamamoto	2004_0392A	4039
513 7590 05/11/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
SAN JUAN, MARTINERIKO P				
ART UNIT		PAPER NUMBER		
2432				
MAIL DATE		DELIVERY MODE		
05/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,972

Applicant(s)

YAMAMOTO ET AL.

Examiner

MARTIN JERIKO P. SAN JUAN

Art Unit

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a response to Applicant's Amendments and Remarks filed on January 26, 2009.

Claims 19-42 are currently pending.

Response to Arguments

1. Applicant's arguments, see Amendments and Remarks, filed January 26, 2009, with respect to the rejection(s) of claim(s) 19-41 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sims III, Applicant's admitted prior art, and Oshima.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 19-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims III [US 2002/0016919 A1], and further in view of Admitted Prior Art [Specification Prior Art Section], and Oshima [US 7191154 B2].

Regarding claim 28, Sims III teaches a content playback method used in a playback terminal for playing back content, the content playback method comprising: reading encrypted content from a portable medium [Sims III 9: 0097 --Encrypted disk key is provided to the play-back device decoder to allow meaningful use of the content recorded thereon.], the encrypted content being generated by encrypting content using

at least medium information pre-recorded on the portable medium [Sims III 6: 0057 -- For example, (Disk Key) in some cases it may be used to encrypt/decrypt content.]; judging whether or not information managed by an external license server is required for decrypting the encrypted content [Sims III 9: 0098]; reading the medium information pre-recorded on the portable medium [Sims III 8: 0091]; acquiring the managed information managed by the external license server when it is judged that the managed information is required [Sims III 9: 0098], the managed information managed by the external license server being part of information which is required for the decryption of the encrypted content [Sims III 9: 0098 --Managed information is associated with rights/authorization of acquiring a cryptographic key necessary in utilizing the content of media.]; and a decryption step of (a) decrypting the encrypted content using only the medium information, without using the managed information managed by the external license server, when it is judged that the managed information is not required, [Sims III 8: 0091] [Sims III 9: 0097] and (b) decrypting the encrypted content using the managed information acquired from the external license server when it is judged that the information is required [Sims III 10: 0106].

Sims III does not teach the encrypted content is being generated by encrypting content using also information pre-stored in the playback terminal, so that encrypted content is decrypted by use of the information pre-stored in the playback terminal itself.

BlueRay and CSS discs teach the encrypted content is being generated by encrypting content using also information pre-stored in the playback terminal, so that encrypted

content is decrypted by use of the information pre-stored in the playback terminal itself [Specification Admitted Prior Art: Page 2: 14-21].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Sims III by also using information pre-stored in the playback terminal when generating encrypted content, so that encrypted content is decrypted by use of the information pre-stored in the playback terminal itself as taught by the admitted prior art. The suggestion/motivation would have been to have encrypted content stored in the medium be tied to a particular playback terminal holding the pre-stored information, since the encrypted content cannot be decrypted with stolen medium information in the absence of the pre-stored information, thus increasing security.

Sims III, in view of the admitted prior art does not teach that when it is judged that the managed information is required, decrypting the encrypted content using the managed information acquired from the external license server, and also the medium information. Oshima teaches that when managed information is required to decrypt encrypted content, the encrypted content is decrypted using the managed information acquired from an external license server [Oshima 6: 42-49], and also medium information [Oshima 6: 58-67].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Sims III in view of the admitted prior art by decrypting encrypted content using the managed information and also medium information, when managed information is required as taught by Oshima. The suggestion/motivation would have been to prevent

decryption of encrypted content using other mediums with stolen acquired managed information, and vice versa, thus increasing security.

Regarding claim 41, Sims teaches the content playback method of claim 28, wherein the managed information managed by the external license server is rights information including usage rights for the content [Sims III 9: 0100 –rights information is associated with determination of single use or unlimited use by external source.], the judging comprises judging whether or not the rights information is required, as the information managed by the external license server, for decrypting the encrypted content [Sims III 9: 0098], the acquiring comprises acquiring the rights information from the external license server when it is judged that the rights information is required [Sims III 9: 100-101 -- acquiring the requested information associated with single use or unlimited use], and the decryption step comprises (a) decrypting the encrypted content using only the medium information, without using the rights information, when it is judged that the rights information is not required [Sims III 8: 0091] [Sims III 9: 0097], and (b) decrypting the encrypted content using the rights information, when it is judged that the rights information is required [Sims III 10: 0106].

Sims III does not teach the encrypted content is being generated by encrypting content using also information pre-stored in the playback terminal, so that encrypted content is decrypted by use of the information pre-stored in the playback terminal itself.

BlueRay and CSS discs teach the encrypted content is being generated by encrypting content using also information pre-stored in the playback terminal, so that encrypted

content is decrypted by use of the information pre-stored in the playback terminal itself [Specification Admitted Prior Art: Page 2: 14-21].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Sims III by also using information pre-stored in the playback terminal when generating encrypted content, so that encrypted content is decrypted by use of the information pre-stored in the playback terminal itself as taught by the admitted prior art. The suggestion/motivation would have been to have encrypted content stored in the medium be tied to a particular playback terminal holding the pre-stored information, since the encrypted content cannot be decrypted with stolen medium information in the absence of the pre-stored information, thus increasing security.

Sims III, in view of the admitted prior art does not teach that when it is judged that the rights information is required, decrypting the encrypted content using the rights information, and also the medium information.

Oshima teaches managed information managed by the external license server is rights information including usage rights for the content [Oshima 6: 47-48 --...time data representing the period of use allowed.], the judging comprises judging whether or not the rights information is required, as the information managed by the external license server, for decrypting the encrypted content [Oshima 5: 12-17 --In order to get a password, the connection address...which is the server of a password issue center...is accessed.], the acquiring comprises acquiring the rights information from the external license server when it is judged that the rights information is required [Oshima 6: 46-49], and the decryption step comprises decrypting the encrypted content using the

rights information [Oshima 6: 42-49], and medium information [Oshima 6: 58-67], when it is judged that the rights information is required [Oshima 5: 13 --In order to get a password...].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Sims III in view of the admitted prior art by decrypting encrypted content using the managed information and also medium information, when managed information is required as taught by Oshima. The suggestion/motivation would have been to prevent decryption of encrypted content using other mediums with stolen acquired managed information, and vice versa, thus increasing security.

Regarding claim 29, Sims III, in view of the admitted prior art, and Oshima teaches the content playback method of claim 41, wherein the medium information includes a media key [Sims III 7: 0071 --Disk Key], and the decryption step includes: a content key obtaining sub-step of, when it is judged that the rights information is not required, obtaining the media key from the medium information and, using the obtained media key, obtaining a first content key used in decrypting of the encrypted content [Sims III 9: 0097 --Use Disk key as Content key]; and a content decryption sub-step of, when it is judged that the rights information is not required, decrypting the encrypted content using the first content key [Sims 6: 0057].

Regarding claim 30, Sims III, in view of admitted prior art and Oshima teaches the content playback method claim 29, wherein the content key obtaining sub-step includes, when it is judged that the rights information is required, obtaining a second content key used in decrypting of the encrypted content [Oshima 6: 65 --The '1-nth' decoding key

is output to the cipher decoder.], using the rights information [Oshima 6: 57-60], and the content decryption sub-step includes, when it is judged that the rights information is required, decrypting the encrypted content using the second content key [Oshima 6: 66-67].

Regarding claim 31, Sims III, in view of admitted prior art and Oshima teaches the content playback method of claim 30, wherein the rights information includes a rights key [Oshima 5: 13 --password], and the content key obtaining sub-step includes, when it is judged that the rights information is required, obtaining the second content key using the rights key [Oshima 6: 55-66].

Regarding claim 32, Sims III, in view of the admitted prior art and Oshima teaches the content playback method of claim 31, wherein the content key obtaining sub-step includes, when it is judged that the rights information is required, obtaining the second content key using both the rights key [Oshima 6: 55 --'1-nth' password] and the media key [Oshima 6: 59 --...decodes with the secret key the mixed keys of the disk ID].

Regarding claim 33, Sims III, in view of the admitted prior art and Oshima teaches the content playback method of claim 30, wherein the portable medium further has stored thereon key obtaining information indicating whether or not the rights information is required for obtaining a key used for decrypting the encrypted content [Sims 8: 0086-0088], and the content playback method further comprises: reading the key obtaining information from the portable medium [Sims 8: 0091] [Sims 9: 0102], wherein the judging comprises judging whether or not the rights information is required for decrypting the encrypted content, based on the key obtaining information [Sims 9:

0098].

Regarding claim 34, Sims III in view of the admitted prior art and Oshima teaches the content playback method of claim 29, wherein the decryption step includes, when it is judged that the rights information is necessary, performing decryption of the encrypted content only when the acquiring has already acquired the rights information [Oshima 6: 58] and the rights information indicates that usage of the content is permitted [Oshima 6: 62-63 --timing data is checked for validity].

Regarding claim 35, Sims III, in view of the admitted prior art and Oshima teaches the content playback method of claim 29, wherein the playback terminal includes a holding unit operable to hold device unique information that is unique to the playback terminal [Sims 4: 0036-0037], the media key is in an encrypted state [Sims 9: 0097 --encrypted Disk Key], having been encrypted using the device unique information [Sims 9: 0097 – encrypted with the public key of the matching “acceptable user”], and the content key obtaining sub-step includes, when it is judged that the rights information is not required, obtaining the media key by decrypting the encrypted-state media key using the device unique information [Sims 9: 0097 --decrypted with the private key of the matching “acceptable user.”].

Regarding claim 36, Sims III, in view of the admitted prior art and Oshima teaches the content playback method of claim 29, wherein the portable medium further has stored thereon information indicating whether or not the rights information is required for decrypting of the encrypted content [Sims 8: 0086-0088], and the content playback method further comprises: reading the information from the portable medium [Sims 8:

0091] [Sims 9: 0102], wherein the judging comprises judging whether or not the rights information is required for decrypting the encrypted content, based on the information [Sims 9: 0098].

Claims 19-27 are rejected because it is similar matter to claims 28-36.

Claim 37 is rejected because it is the portable recording medium comprising the same elements as claim 19.

Claim 38 is rejected because it is similar matter to claim 41.

Regarding claim 39, Sims III, in view of admitted prior art and Oshima teaches the playback terminal of claim 20, wherein the rights information includes information showing permission to play back the content [Oshima 6: 62-63 --timing data representing the period of use allowed.].

Regarding claim 40, Sims III teaches the playback terminal of claim 39, wherein the portable medium further has recorded thereon information indicating whether or not the rights information is necessary for decrypting the encrypted content [Sims 6: 0057-0066], and the decryption method judgment unit judges whether or not the rights information is required for decrypting the encrypted content based on the information recorded on the portable medium [Sims 8: 0091; 9: 0098; 9: 0102].

Regarding claim 42, Sims III in view of admitted prior art and Oshima teaches the playback terminal of claim 26, wherein the encrypted-state media key is generated for transmission to the playback terminal by encrypting the media key [Sims III 6: 0053] using device information of valid playback terminals [Sims III 8: 0082], and the content key obtaining unit fails to obtain the media key by decrypting the encrypted state media

key, when the device information of the playback terminal itself is not included in the device information of the valid playback terminals [Sims III Fig 3A: Itm 308 --If no matches, an update of acceptable user list with public key must be obtained, or else an inherent failure to obtain the media key by the player.]. Furthermore, Sims III in view of admitted prior art and Oshima teaches the media key is recorded on the recording medium in another encrypted state or masked state [Sims 7: 0072 --the Disk Key is the XOR of all requested keys.].

Sims III in view of the admitted prior art and Oshima does not teach the encrypted-state media key recorded on the recording medium is generated by encrypting the media key using device information of valid playback terminals.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the encrypted state of the media key for storing in the medium, and the encrypted state of the media key for transmitting to the playback terminal to be the same, since it has been held that making an integral structure involves only routine skill in the art. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965), and since it has been held that the combination of familiar elements, according to the disclosed teachings, is likely to be obvious when it does no more than yield "predictable results." (See *KSR Int'l v Teleflex Inc.*)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN JERIKO P. SAN JUAN whose telephone number is (571)272-7875. The examiner can normally be reached on M-F 8:30a - 6:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

/Martin Jeriko San Juan/
Examiner, Art Unit 2432

/Gilberto Barron Jr./
Supervisory Patent Examiner, Art Unit 2432